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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,233	07/13/2000	AKITOSHI KOJIMA	P-9904 S	1035
28752	7590	02/23/2005	EXAMINER	
LACKENBACH SIEGEL, LLP LACKENBACH SIEGEL BUILDING 1 CHASE ROAD SCARSDALE, NY 10583			MOORTHY, ARAVIND K	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,233

Applicant(s)

KOJIMA, AKITOSHI

Examiner

Aravind K Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's amendment on 24 January 2005.
2. Claims 12-16 are pending in the application.
3. Claims 12-16 have been rejected.
4. Claims 1-11 have been cancelled.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 January 2005 has been entered.

Response to Arguments

6. Applicant's arguments with respect to claims 12-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Rai et al U.S. Patent No. 6,675,208 B1.

As to claim 12, Rai et al discloses a network system comprising:

individual service provider devices each having a first authentication server and access point terminals for connecting user terminals of contracted users of at least one of the individual service provider devices to a network [column 9, lines 21-43];

a parallel service provider device connected to the individual service provider devices, the parallel service provider device having a roaming contract with the individual service provider devices and including a second authentication server [column 9 line 61 to column 10 line 13]; and

wherein each of the individual service provider devices comprises:

determining means for determining whether a user who issues a connection request from a user terminal is a contract member of the parallel service provider device [column 27, lines 13-22];

transmitting means for transmitting the connection request to the parallel service provider device to cause the second authentication server

of the parallel services provider device to perform user authentication when the user is a contract member [column 19, lines 51-67];

authentication means for causing the first authentication server of the individual service provider devices to perform user authentication when the user is not a contract member [column 20, lines 1-50]; and

connecting means for connecting the user terminal to the network and charging the user for connection when a result of user authentication is good [column 31, lines 18-46].

As to claim 13, Rai et al discloses that the connection request comprises an e-mail address including a domain name of the parallel service provider device [column 9 line 61 to column 10 line 13]. Rai et al discloses that the determining means determines whether the user is a contract member based on the presence or absence of the domain name of the parallel service provider device in the connection request [column 9 line 61 to column 10 line 13].

As to claim 14, Rai et al discloses that the parallel service provider device is connected to the individual service provider devices through an exclusive line [column 5 line 56 to column 6 line 5].

As to claim 15, Rai et al discloses that the individual service provider devices send respective user connection logs to the parallel service provider device [column 6, lines 40-53].

As to claim 16, Rai et al discloses that the parallel service provider device comprises:

receiving means for receiving a user name for a user terminal of a user who requests a signup [column 9 line 61 to column 10 line 13]; and

further determining means for determining whether e-mail addresses including a combination of the input user name and sub-domains of the parallel service provider device has been registered so as to register one of non-registered e-mail addresses [column 9 line 61 to column 10 line 13].

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
February 15, 2005

AM

Eugene J. Lamarre
Primary Examiner